

## REMARKS

The office action of March 9, 2006 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 65 remain in this case, claims 1, 33 and 36 being amended and claims 66-67 being cancelled by this response. The Applicant reserves the right to pursue claims 66-67 in one or more divisional applications.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

### **Objections to the Amendment**

3. The Examiner stated that the amendment filed 12/12/2005 was objected to under 35 U.S.C. 132(a) because it introduced new matter into the disclosure.

More specifically, the Examiner stated that the amended limitations cited in independent claims 1 and 33 as "at least the first address and communication contents to a forwarding service separate from the sender's service provider" in lines 4-5 are considered as new subject matter. The Applicant respectfully disagrees.

In the present invention, the communication does not follow its usual path from sender to sender's standard communications channel to recipient's communications service to recipient but rather (after having been returned to sender) goes out again, this time from sender to sender's communications service to a separate server called the forwarding service to recipient's new communications service to recipient's new address (i.e. not the "standard communications channel" that one would have used to send a message to a particular recipient, if that "channel" were working).

Although the Applicant disagrees with the rejection, claims 1 and 33 have been amended to overcome the rejection. The present application clearly supports amended claims 1 and 33 on page 8, lines 9-12, which states "[s]ender 1 now attempts to contact recipient by sending the message 5 to forwarding service 6 (separate from standard communications channel provided by first communications service) where recipient may have registered his old address 3 and his current address 7 to which communications are to be forwarded".. In addition, the separate

server of the forwarding service is defined in the present application. “The means of forwarding is referred to herein as ‘indirect forwarding’ because the communication is not directed to the known, old address as would normally be done if the address were operational, **but through a separate server, herein called a "forwarding service"**, and then on to another address. It will be understood that in this context, **the term "separate server" means a service which is not the same as a communications service which would ordinarily be used to send the message from the sender to the recipient**, but which might be owned by or a subsidiary part of an ordinary communications service, or might be an independent entity. (present application, page 6, lines 20-27, emphasis added). The forwarding service is on a different communications channel than the standard communications channel that the sender would normally use to send the message from the sender to the recipient. The following additional passages also support the amended language of the present claims: page 6, lines 28 through page 7, line 2; page 7, lines 7 through 14; page 13, lines 8 through 12; page 14, lines 5-11; page 15, lines 18- 22; page 16, lines 4-5; page 17, lines 11-15. In addition, Figure 3 shows the user of the service receiving an error message from the recipient’s communications service and then “attempts contact using known address via FS (the forwarding service)” – here again, it is the user who initiates contact directly with the forwarding service.

It is also clear in the examples used in other media, e.g. postal mail (starting on page 18, line 25) and telephone (starting on page 20, line 14), that the forwarding service is separate from the sender’s standard communications channel provided by the communications service (analogous to ISP in the e-mail example).

Reconsideration and withdrawal of the objection are respectfully requested.

### **Rejection(s) under 35 U.S.C. §102**

6. Claims 1-6,12-17,20,21,23,24,26,27,29-39,45-50,53,54,56,57,59,60, and 62-65 were rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei U. S. Patent 6,654,779.

Applicant respectfully disagrees with this rejection, as applied to the claims as amended by this response.

The amended independent claims 1 and 33 recite the Applicant's claimed method as:

1. A method of indirectly forwarding a communication from a sender to a recipient where a first address for the recipient is known or believed to be temporarily or permanently invalid, by sending the communication comprising at least the first address and communication contents to a forwarding service, comprising the steps of:

- a) the forwarding service receiving the communication;
- b) the forwarding service looking up at least the first address in a database wherein the first address is registered with the forwarding service;
- c) the forwarding service retrieving at least one second address from the database, wherein the second address is registered with the forwarding service, which second address is associated with the first address; and
- d) the forwarding service sending the communication to the second address;

wherein the forwarding service is separate from a standard communications channel provided by a communications service and has an address different from that of the recipient; and

wherein the communication is indirectly forwarded to the recipient.

33. A method of a sender sending a communication to a recipient via a forwarding service when a first address for the recipient is known or believed to be temporarily or permanently invalid, comprising the step of the sender sending the communication to a forwarding service separate from a standard communications channel provided by a communications service-and having an address different from that of the recipient, the communication comprising at least the first address and communication contents.

These amendments are fully supported by the application, as filed, on page 10, lines 2-6 and page 8, lines 9-12. No new matter has been added. “The indirect forwarding service contemplated herein generally relies upon registration by the prospective recipient of a

communication. The minimum information a registrant would provide to the forwarding service is one data pair -- an old address and a forwarding address (in this document described using the syntax *old address:forwarding address*) (page 10, lines 2-6).

The Applicant's claimed invention, in contrast to Tsuei's system, is an indirect forwarding system that uses a novel forwarding service. "The means of forwarding is referred to herein as 'indirect forwarding' because the communication is not directed to the known, old address as would normally be done if the address were operational, but through a separate server, herein called a 'forwarding service', and then on to another address. It will be understood that in this context, the term 'separate server' means a service which is not the same as a communications service which would ordinarily be used to send the message from the sender to the recipient, but which might be owned by or a subsidiary part of an ordinary communications service, or might be an independent entity." (present application, page 6, lines 20-27).

In Tsuei's system, the sender sends his/her e-mail through his/her communications service (ISP) to the recipient at its old address. When the e-mail bounces, **the sending ISP sends only the first e-mail address to an E-mail Address Management System (EAMS)** (figure 4, 445). The EAMS looks up the address (450) and **responds to the ISP with a second e-mail address (462). The sender's ISP then sends the new address to the sender (465), and readdresses and resends the undeliverable message to the second address (470).** In an alternate embodiment, Tsuei's EAMS sends the new address to the Sender, directly, and the Sender then readdresses and resends the message. **Tsuei's EAMS never handles the message (the contents of "the communication") itself, and neither the sender nor the sender's standard communications channel ever send the communication to anything but the recipient's address.**

Contrast this with the Applicant's invention, as defined in the amended claims:

**The sender**, knowing the recipient's first address to be invalid, **sends the entire communication** (first address and contents) through a communications service **to a forwarding service, which has a different address from the recipient and is separate from a standard communications channel provided by the communications service. The forwarding service**

looks up a second address which is related to the first address, and **forwards the communication to the second address**.

The present claims pertain to **the communication as a whole**, e.g. an e-mail message, and **not simply the recipient's address**. The communication is forwarded by the forwarding service rather than being returned to the sender or sender's communications service for readdressing and reprocessing. Using the Applicant's invention, the communication is simply forwarded to the recipient at the second address, in one step and without necessarily revealing the updated address to the sender or sender's communication service. In addition to increased efficiency, this method can maintain the privacy of the recipient's new address since it need never be disclosed to the sender, the sender's computer or the sender's communications service.

The claims have been amended to clarify the invention - specifically, that:

- A sender sends the entire communication (known invalid first address and contents) through a communications service to a forwarding service separate from a standard communications channel provided by the communications service (claim 33)
- The forwarding service retrieves a second, related address from a database, wherein the second address is registered with the forwarding service (claims 1 and 36). The database of registered information is a part of the forwarding service, and not a separate database or system.
- The forwarding service forwards the communication on to the second, related address - the sender does not resend the message, and need not ever know the second address.

The Examiner states that “Even that, Figure 3 clearly discloses the limitations of the claimed invention. The forward service as mail forwarder 114 is separated from the sender ISP communication which received a whole email from sender 110 and lookup second new address from EAMS 330 if fails. It then sends to the sender 110 the new address for notification purposes, the mail forwarder sends to the new recipient directly the intended email as clearly

seen in Figure 4 and col. 10, lines 30-50.” (present office action dated March 9, 2006, page 3, lines 13-18).

The following passage is part of the description of Figure 3 in Tsuei.

In another embodiment of the invention, a sender 110 who receives a bounce message can himself or herself query the EAMS 330 over the Internet 130 to determine if the intended recipient 150 has registered an address change with the EAMS 330. In such an embodiment, the query may be conducted via e-mail. Alternatively, the EAMS 330 may have a web site interface (i.e., an http interface) that allows a sender 110 to input an e-mail address and determine if that e-mail address is correlated with a new e-mail address. This aspect of the invention is useful where the ISP of the sender 110 is not configured to automatically query the EAMS 330 to obtain a new e-mail address in response to receipt of a bounce message. In this situation, the sender 110 who finds a new address after making a query of the EAMS 330 can then use the new address to resend the message that caused the bounce message in the first place. The sender 110 may also want to query the EAMS 330 about an address change if the sender suspects, even before sending an e-mail, that the intended recipient 150 has changed addresses.

In yet another embodiment of the present invention, a sender may be provided with forwarding software that is stored on the sender's computer. The forwarding software is responsive to receipt of a bounce message indicating that a message previously sent by the sender could not be delivered (i.e., the software is automatically responsive to the text string "message undeliverable" contained in an e-mail message). Upon receiving such a bounce message, the forwarding software can initiate a query to the EAMS 330 to determine if the EAMS 330 has a record associating a new e-mail address with the e-mail address of the message that could not be delivered. The EAMS 330 then notifies the forwarding software preferably via e-mail, of the results of the query, and the EAMS 330 includes the new address if one is found. Upon notification that there exists a new address, the forwarding software automatically forwards the message that previously could not be delivered to the new address.

In FIG. 3, a mail forwarder 114 is also shown connected to the Internet 130. A mail forwarder 114 is capable of receiving an e-mail message at a given e-mail address over the Internet. After receiving the e-mail message, the mail forwarder 114 then sends the message back out onto the Internet to another Internet address. The address to which the e-mail message is forwarded may be determined by software used to operate the mail forwarder 114, or alternatively the mail forwarder may look to the contents of the e-mail itself for instructions on where to send the e-mail.

The mail forwarder 114, the sender ISP 120, and the sender 110 are all sending entities 112 that are capable of sending and receiving e-mail messages. One skilled in the art should recognize that various embodiments of the present invention are possible in which any one of the sending entities attempts to send an e-mail message using a first address, receives a "message undeliverable" error, queries the EAMS 330 based on the first address, receives a second address over the Internet from the EAMS 330 in response to the query, and then resends the e-mail message using the second address.” (Tsuei, col. 7, line 53 through col. 8, line 44).

Even assuming that the mail forwarder is equivalent to a forwarding service (which the Applicant does not concede), the mail forwarder in Tsuei does not have any addresses registered with it. Instead, as shown in Figure 3 of Tsuei, the mail forwarder in Tsuei queries an independent EAMS across the internet for the second address. Assuming alternatively that the EAMS is equivalent to a forwarding service (which the Applicant does not concede), a sending entity **does not** send an entire communication to the EAMS, but rather the sending entity queries the EAMS for the second address and re-mails the e-mail. In addition, the EAMS does not forward any communications to the second address. The EAMS is merely the database being used by the mail forwarder to obtain a second address.

There is nothing in this passage or anywhere else in Tsuei that discloses an indirect forwarding service separate from a standard communications channel provided by the sender's communications service. In fact, the passage specifically states that "[o]ne skilled in the art should recognize that various embodiments of the present invention are possible in which **any one of the sending entities** attempts to send an e-mail message using a first address, receives a "message undeliverable" error, **queries the EAMS 330** based on the first address, **receives a second address over the Internet from the EAMS 330 in response to the query, and then resends the e-mail message using the second address.**" The mail forwarder 114 is one such entity, and as such uses a direct forwarding method, which uses the EAMS. Upon a sending failure, mail forwarder 114 retrieves a corrected address from the EAMS, then readdresses and forwards the message on its own; it does not rely on the EAMS to forward the message contents. The mail forwarder 114 is not equivalent to the forwarding service in claims 1 and 33, but merely stands in for Tsuei's sender or sender's communication service under a different name.

The forwarding service of the present invention both retrieves a second address registered with the forwarding service and forwards an entire communication to that address. Tsuei does not disclose such a forwarding service- the mail forwarder does not retrieve an address registered with itself and the EAMS does not forward an entire communication to a second address. Therefore, neither the mail forwarder nor the EAMS in Tsuei are equivalent to the forwarding service of the present invention.

Since Tsuei lacks the key elements of Applicant's claims -the sender sends the communication to a forwarding service separate from a standard communications channel provided by the communications service which receives the communication, looks up the address, retrieves the new address that is registered with the forwarding service, and forwards the communication - Applicant believes that the Tsuei reference does not anticipate his invention claimed in claims 1 and 33, and these claims are thus patentable over the cited patent. The dependent claims, being dependent upon and further limiting independent claims 1 and 33, should also be allowable for the same reasons, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejections are respectfully requested.

### **Rejection(s) under 35 U.S.C. §103**

28. Claims 7-11,18-19,28,40-44,51-52, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Fuisz U.S. Patent 6,643,688.

Applicant does not believe that Tsuei teaches or suggests the invention claimed in independent claims 1 and 33, as amended and the claims dependent upon those claims, for the reasons discussed above. The previous argument relative to the section 102 rejection over Tsuei is therefore repeated here by reference.

Fuisz is an e-mail redirector or forwarder, commonly known as an "anonymous remailer". In Fuisz system, the user sets up a user account, and any mail sent to that account is automatically forwarded to one or more other accounts based on filters.

It is not necessary to speculate as to what the combination of Tsuei and Fuisz would produce, as Tsuei already includes a forwarder of the general type represented by Fuisz - see figure 3, "Mail Forwarder" (114). If you replace element (114) in figure 3 with Fuisz, there is effectively no change in Tsuei's system, except that element (114) would have more than one line connecting it to (130) "Internet". The operation of the system would be the same, in that if a message sent by Fuisz's remailer to one of the accounts bounces, the remailer would send an address query to the EAMS, and if the old account is in the database, would receive a new address message from the EAMS, and it would then re-send the message to the new address.



The combination of Tsuei and Fuisz, then, would be the EAMS of Tsuei, used by the remailer of Fuisz, and would not be the forwarding service of the present application.

As neither Tsuei nor Fuisz teaches or suggests Applicant's system of a sender using a communications service to send communications to a forwarding service separate from a standard communications channel provided by the communications service, and the communications being forwarded by the forwarding service to a second address related to the first address, as described in the amended claims, the combination of the two cannot teach it or make it obvious. Reconsideration and withdrawal of the rejection is respectfully requested.

32. Claims 22, 25, 55, and 58, rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

In making this rejection, the Examiner stated "Tsuei discloses sending the communication to the second address further comprises the step of including additional information in the communication, and send the confirmation to the sender; however, Tsuei fails to teach additional information is advertising, the confirming communication also comprises additional information at least in the form of advertising."

These claims are dependent upon independent claim 1 (claims 22, 25) or 33 (claims 55, 58), as amended. The arguments as to why Tsuei does not show the invention as claimed in the amended independent claims, as recited above in response to the section 102 rejection, are repeated here by reference. These dependent claims merely narrow the independent claims by defining additional material (advertising) which is added to the forwarded communication sent to the recipient (claims 22, 55) or which is added to a confirming message sent back to the sender (claims 25, 58). With the basic system being novel, adding this material to the forwarded communication does not render the combination obvious.

Reconsideration and withdrawal of the rejection is respectfully requested.

### **Conclusion**

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with

Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

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